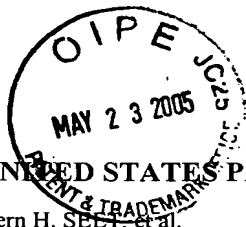


Docket No. 246121US8CONT



IPW

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF: Chern H. SEEN, et al.

SERIAL NO: 10/751,429

GAU: 3622

FILED: January 6, 2004

EXAMINER: CHAMPAGNE, DONALD

RCE FILED: May 6, 2005

FOR: METHOD AND SYSTEM FOR ADVERTISEMENT USING INTERNET BROWSER WITH BOOK-LIKE INTERFACE

INFORMATION DISCLOSURE STATEMENT UNDER 37 CFR 1.97

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

Applicant(s) wish to disclose the following information.

REFERENCES

- ☒ The applicant(s) wish to make of record the attached Chinese Office Action dated April 1, 2005. Copies of the listed references are attached, where required, as are either statements of relevancy or any readily available English translations of pertinent portions of any non-English language references.
- ☐ A check or credit card payment form is attached in the amount required under 37 CFR §1.17(p).

RELATED CASES

- ☐ Attached is a list of applicant's pending application(s), published application(s) or issued patent(s) which may be related to the present application. In accordance with the waiver of 37 CFR 1.98 dated September 21, 2004, copies of the cited pending applications are not provided. Cited published and/or issued patents, if any, are listed on the attached PTO form 1449.
- ☐ A check or credit card payment form is attached in the amount required under 37 CFR §1.17(p).

CERTIFICATION

- ☒ Each item of information contained in this information disclosure statement was first cited in any communication from a foreign patent office in a counterpart foreign application not more than three months prior to the filing of this statement.
- ☐ No item of information contained in this information disclosure statement was cited in a communication from a foreign patent office in a counterpart foreign application or, to the knowledge of the undersigned, having made reasonable inquiry, was known to any individual designated in 37 CFR §1.56(c) more than three months prior to the filing of this statement.

DEPOSIT ACCOUNT

- ☒ Please charge any additional fees for the papers being filed herewith and for which no check or credit card payment is enclosed herewith, or credit any overpayment to deposit account number 15-0030. A duplicate copy of this sheet is enclosed.

Respectfully submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.

Bradley D. Lytle

Registration No. 40,073

Customer Number

22850

Tel. (703) 413-3000
Fax. (703) 413-2220
(OSMMN 05/03)

I:\ATTY\MM\24\S\246121US\246121US IDS 05-23-05.doc

Michael E. Monaco
Registration No. 52,041

BEST AVAILABLE COPY

THE PATENT OFFICE OF THE PEOPLE'S REPUBLIC OF CHINA

Address: 6 Xi Tu Cheng Lu, Haidian, Beijing

Post Code: 100088

| | | |
|-------------------------|--|---------------------------------------|
| Applicant: | E-BOOK SYSTEMS PTE. LTD. | Date of Notification: 2005-4-1 |
| Attorney: | | |
| Application No.: | 01817265.2 | |
| Title of the Invention: | METHOD AND SYSTEM FOR ADVERTISEMENT USING INTERNET BROWSER WITH BOOK-LINE INTERFACE | |

Notification of the First Office Action (PCT Application in the National Phase)

- ☒ The applicant requested examination as to substance on and examination has been carried out on the above-identified patent application for invention under Article 35(1) of the Patent Law of the People's Republic of China (hereinafter referred to as "the Patent Law").
☐ The Chinese Patent Office has decided to examine the application on its own initiative under Article 35(2) of the Patent Law.
- ☒ The applicant claimed priority/priorities based on the application(s):
 filed in US on 2000-10-12, filed in _____ on _____,
 filed in _____ on _____, filed in _____ on _____.
- ☐ The following amendments submitted by the applicant are not acceptable under Art. 33 of the Patent Law:
 - ☐ The Chinese translation of the amendments annexed to the IPEA Report.
 - ☐ The Chinese translation of the amendments made under Art. 19 of PCT.
 - ☐ The amendments made under Art. 28 or Art. 41 of PCT.
 - ☐ The amendments made under Rule 51 of the Implementing Regulations of the Patent Law.
 Specific reasons why the amendments are not acceptable are set forth in the text portion of this Notification.
- ☐ Examination was directed to the Chinese translation of the International Application as originally filed.
☒ Examination was directed to the application documents as specified below:
 - ☐ Description ☒ Pages 1-30 of the Chinese translation of the International Application as originally filed.
 - ☐ Pages _____ of the Chinese translation of the amendments annexed to the IPEA Report.
 - ☐ Pages _____ of the amendments made under Art. 28 or Art. 41 of PCT.
 - ☐ Pages _____ of the amendments made under Rule 51 of the Implementing Regulations of the Patent Law.
 - ☐ Claims
 - ☐ The Chinese translation of claims _____ of the International Application as originally filed.
 - ☐ The Chinese translation of claims _____ of the amendments made under Art. 19 of PCT.
 - ☐ The Chinese translation of claims _____ of the amendments annexed to the IPEA Report.
 - ☒ The Chinese translation of claims 1-27 of the amendments made under Art. 28 or Art. 41 of PCT.
 - ☐ The amendments of the claims _____ made under Rule 51 of the Implementing Regulations of the Patent Law.
 - ☐ Drawings
 - ☒ Pages 2-18 of the Chinese translation of the International Application as originally filed.
 - ☐ Pages _____ of the Chinese translation of the amendments made under Art. 19 of PCT.
 - ☐ Pages _____ of the Chinese translation of the amendments annexed to the IPEA Report.
 - ☒ Pages 1 of the amendments made under Art. 28 or Art. 41 of PCT.
 - ☐ Pages _____ of the amendments made under Rule 51 of the Implementing Regulations of the Patent Law.
- ☐ Below is/are the reference(s) cited in this Office Action (the reference number(s) will be used throughout the examination procedure):

| No. | Number(s) or Title(s) of Reference(s) | Date of Publication (or the filing date of conflicting application) |
|-----|---------------------------------------|--|
| 1 | | _____ |
| 2 | | _____ |
| 3 | | _____ |
| 4 | | _____ |
| 5 | | _____ |

6. Conclusions of the Action:

☒ On the Specification:

- ☐ The subject matter contained in the application is not patentable under Article 5 of the Patent Law.
- ☐ The description does not comply with Article 26 paragraph 3 of the Patent Law.
- ☒ The draft of the description does not comply with Rule 18 of the Implementing Regulations.
- ☐ The draft of the description does not comply with Rule 19 of the Implementing Regulations.

☒ On the Claims:

- ☒ Claim(s) 27 is/are not patentable under Article 25 of the Patent Law.
- ☐ Claim(s) _____ does/do not comply with the definition of inventions prescribed by Rule 2 paragraph 1 of the Implementing Regulations.
- ☐ Claim(s) _____ does/do not possess the novelty as required by Article 22 paragraph 2 of the Patent Law.
- ☐ Claim(s) _____ does/do not possess the inventiveness as required by Article 22 paragraph 3 of the Patent Law.
- ☐ Claim(s) _____ does/do not possess the practical applicability as required by Article 22 paragraph 4 of the Patent Law.
- ☐ Claim(s) _____ does/do not comply with Article 26 paragraph 4 of the Patent Law.
- ☐ Claim(s) _____ does/do not comply with Article 31 paragraph 1 of the Patent Law.
- ☒ Claim(s) 1,2,4,8,9,13,14,16,17,21,23 does/do not comply with the provisions of Rule 20 of the Implementing Regulations.
- ☒ Claim(s) 1,17,26 does/do not comply with the provisions of Rule 21 of the Implementing Regulations.
- ☐ Claim(s) _____ does/do not comply with the provisions of Rule 12 paragraph 1 of the Implementing Regulations.

The explanations to the above conclusions are set forth in the text portion of this Notification.

7. In view of the conclusions set forth above, the Examiner is of the opinion that:

- ☐ The applicant should make amendments as directed in the text portion of the Notification.
- ☒ The applicant should expound in the response reasons why the application is patentable and make amendments to the application where there are deficiencies as pointed out in the text portion of the Notification, otherwise, the application will not be allowed.
- ☐ The application contains no allowable invention, and therefore, if the applicant fails to submit sufficient reasons to prove that the application does have merits, it will be rejected.

8. The followings should be taken into consideration by the applicant in making the response:

- (1) Under Article 37 of the Patent Law, the applicant should respond to the office action within 4 months counting from the date of receipt of the Notification. If, without any justified reason, the time limit is not met, the application shall be deemed to have been withdrawn.
- (2) Any amendments to the application should be in conformity with the provisions of Article 33 of the Patent Law. Substitution pages should be in duplicate and the format of the substitution should be in conformity with the relevant provision contained in "The Examination Guidelines".
- (3) The response to the Notification and/or revision of the application should be mailed to or handed over to the "Reception Division" of the Patent Office, and documents not mailed or handed over to the Reception Divisions have no legal effect.
- (4) Without an appointment, the applicant and/or his agent shall not interview with the Examiner in the Patent Office.

9. This Notification contains a text portion of pages and the following attachments:

- ☐ cited reference(s), totaling pages. ☐

Examination Dept. _____ Examiner: _____

Seal of the Examination Department

TEXT OF THE FIRST OFFICE ACTION

Application Number: 018172652

The following are the examiner's comments:

1. Claim 27 belongs to the scope prescribed in Article 25, paragraph one, item two of the Patent Law, which is not patentable. Although the claim seeks to protect a computer readable medium, said computer readable medium do not possess any physical features, which differ from the prior art and contribute to the present invention. In substance, the claim seeks to protect computer program instructions recorded in the computer readable medium, that is, computer program itself. Therefore, claim 27 is not patentable.

2. Claim 1 does not describe detailed operational steps for "dynamically inserting an advertisement at an advertising location within said one or more flipping pages", causing that the skilled persons in the art do not know the meaning of word "dynamically" and the its embodiments, and thus a complete technical solution cannot be formed simply on the basis of the present content in this claim. Therefore, claim 1 is not in conformity with Rule 21, paragraph two of the Implementing Regulations of the Patent Law. The applicant should incorporate detailed technical features of the step of "dynamically inserting" into this claim.

The same defect also exists in "dynamically inserted" in claim 17 and "dynamically inserting" in claim 26, and thus claims 17 and 26 are not in conformity with Rule 21, paragraph two of the Implementing Regulations of the Patent Law. The applicant should amend it.

3. The meaning of "organizing sequentially said content" in claim 1 is unclear. It is unclear what does "content" refer to, thus making the protection scope of claim 1 unclear. Therefore, claim 1 is not in conformity with Rule 20, paragraph one of the Implementing Regulations of the Patent Law. The applicant should amend it to "electronic content". The same defect also exists in claims 2, 4, 9 and 14, making claims 2, 4, 9 and 14 not in conformity with Rule 20, paragraph one of the Implementing Regulations of the Patent Law. The applicant should amend it.

4. The meaning of the sentence "reorganizing a portion of said content around said advertising location of said advertisement" in claim 2 is unclear. It is unclear of the detailed operational manner of "reorganizing" and its anticipated object, what content does "a portion of said content" refer to, and what is the difference between this content and other portion of content. This makes the protection scope of claim 2 unclear, and thus is not in conformity with Rule 20, paragraph one of the Implementing Regulations of the Patent Law.

5. What does "displaying step" in claim 8 refer to is unclear. The "displaying step" does not appear in claim 1, which is referred to by claim 8. This makes the protection scope of this claim unclear, and is not in conformity with Rule 20, paragraph one of the Implementing Regulations of the Patent Law.

The same defect also exists in "selecting step" and "displaying step" in claim 13, and "inserting step" in claim 16. This makes the protection scope of claims 13 and 16 unclear, and thus is not in conformity with Rule 20, paragraph one of the Implementing Regulations of the Patent Law. The applicant should amend it.

6. (This item relates to Chinese wording. Translation omitted.)

7. The meaning of the sentence "said one or more flipping pages includes at least two flipping pages" in claim 16 is contradictory. The contradiction exists when the sentence is read as "one flipping page includes at least two flipping pages". This makes the protection scope of claim 16 unclear, and thus is not in conformity with Rule 20, paragraph one of the Implementing Regulations of the Patent Law.

8. Claim 17 is a product claim, however, the applicant does not describe it with structural feature. The presented features like "browseable electronic book", "discrete amounts of content" and "advertisement" are not the product's structural features. This makes the protection scope of claim 17 unclear, and thus is not in conformity with Rule 20, paragraph one of the Implementing Regulations of the Patent Law.

Similarly, the feature "spine representation" mentioned in

claim 23 is not a product's structural feature. This makes the type of claim 23 unclear, and thus is not in conformity with Rule 20, paragraph one of the Implementing Regulations of the Patent Law. The applicant should amend it.

9. The sentence "said advertisement and said second advertisement originate from a same advertiser" in claim 21 is not the technical feature which defines the protection scope, but a description of some non-technical features like the origin of the advertisement. This does not make claim 21 concise, and thus is not in conformity with Rule 20, paragraph one of the Implementing Regulations of the Patent Law. The applicant should remove the above-mentioned contents.

10. (This item relates to Chinese wording. Translation omitted.)

For the reasons as stated above, the application cannot be allowed in the present form. The applicant should submit a new claim and/or specification in accordance with this notification within the specified time limit. The applicant should note that, pursuant to Article 33 of the Patent Law, the amendments may not go beyond the scope of disclosure contained in the initial specification and claims. Any active amendment that deviates from this notification will make the amended document unacceptable. If the applicant fails to overcome the above-mentioned defects within the specified time limit in this notification or fails to present convincing reasons why the application is conformity with said prescription, the application shall be rejected.

Comments of the Attorney

Regarding item 1 of the text portion of this Office Action, you might delete claim 27.

Regarding item 2, you might further define how to perform dynamic inserting in claims 1, 17 and 26.

Regarding items 3, 4 and 7, you might amend claims 1, 2, 4, 9, 14 and 16 to be clear.

Regarding item 5, you might argue that the defects as indicated in this item do not exist.

Regarding items 6 and 10, it can be attended to at our end.

Regarding item 8, you might redefine the products of claims 17 and 23 with their structural features that are supported by the specification.

Regarding item 9, it may be helpful to argue that "said advertisement and said second advertisement originate from a same advertiser" is potentially a technical feature.

BEST AVAILABLE COPY